

## REMARKS

### I. Status of the Claims

Claims 1-84, 89, 91, 92, 94, and 144 were previously cancelled.

Without prejudice or disclaimer, claims 85, 86, 93, 95-108, 111-134, 142, 143, 176, 183, and 184 have been amended herein. Support for those amendments can be found, for example, at page 14, lines 12-14. Accordingly, no new matter is added herein.

Claims 101-103, 117-134, 138-140 (instead of 137-140 as indicated by the Office in the Office Action), and 176-184 are withdrawn as being directed to non-elected inventions.

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 are pending and subject to examination with entry of this amendment.

In addition, for the record, the instant application currently claims cosmetic composition comprising, in a cosmetically acceptable organic liquid medium, at least one non-elastomeric film-forming ethylenic linear block polymer and **at least one gelling agent** for the organic liquid medium, not a composition comprising "(1) a block polymer, and (2) an organic liquid medium, the organic liquid medium comprising (3) a **non-volatile liquid fatty phase**" (Emphasis Added) as the Office stated in the Office Action at page 3. Moreover, the copolymer elected by Applicants in the Response filed September 14, 2009, is isobornyl methacrylate /acrylic acid /isobutyl acrylate, wherein one block comprises isobornyl methacrylate /acrylic acid, the other block comprises isobutyl acrylate, and an intermediate block comprises isobutyl acrylate and at least one monomer chosen from isobornyl methacrylate and acrylic acid, not the copolymer as the Office stated at the first paragraph of page 4 of the Office Action.

## II. Allowable Subject Matter

Applicants acknowledge the Office's indication that the claims would be allowable if limited to the elected block copolymer.

## III. Claim rejections - 35 U.S.C. § 112

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for the elected species of block copolymer, allegedly does not reasonably provide enablement for any other block copolymer. *See* Office Action at pages 2-6. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

The Office concludes that the specification provides no enablement for the whole scope of the claims. The Office alleges that the T<sub>g</sub> of a polymer is unpredictable because T<sub>g</sub> must be measured by experiment. While Applicants disagree with the Office's position, Applicants note that the T<sub>g</sub> values referred to in the instant application are **theoretical** T<sub>g</sub> values determined by Fox's law:

$$1/T_g = \sum_i (\omega_i/T_{gi}).$$

*See* lines 1-14 at page 14 of the specification as filed. As such, in the instant application, the T<sub>g</sub> value of a block depends only on the mass fraction ( $\omega_i$ ) of its constituent monomer  $i$  and the **theoretical** glass transition temperature (T<sub>gi</sub>) of the homopolymer formed by the constituent monomer  $i$ , wherein the theoretical T<sub>gi</sub> can be found in the literature, such as Polymer Handbook, 3<sup>rd</sup> Edition, 1989, John Wiley.

Thus, contrary to the Office's statement that "the artisan would have to start from scratch, using trial and error experimentation in an attempt to uncover a polymer that

had the requisite Tg properties", an artisan only needs to calculate the individual weight percentage of a monomer to be used in a block so as to obtain the desired theoretical Tg.

Moreover, in addition to providing six detailed experimental procedures (see Examples 1-4 at pages 31-36, and Examples 5 and 6 at pages 39-41), rather than "the sole working example" as stated by the Office, of preparing the block polymer, the specification also describes many other block polymers by listing their constituent monomers in each block. See pages 28-31 and pages 37-39. As admitted by the Office, a skilled artisan in the art is capable of following the detailed experimental procedure to prepare the other block polymers.

As such, the specification provides ample guidance for a skilled artisan to practice the invention without undue experimentation. Applicants respectfully requests that the rejection be withdrawn.

#### **IV. Double Patenting**

Claims 85-88, 90, 93, 95-100, 104-116, 135-137, and 141-175 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 5, 8-22, 24-26, and 68-120 of copending Application No. 10/949,435, over claims 85-88, 90, 93, 95-100, 104-116, 135-17, and 141-175 of copending Application No. 10/529,265, over claims 87-89, 91, 93-142, 144-153, and 155-181 of copending Application No. 10/529,267, over claims 1-8 and 10-59 of copending Application No. 10/573,579, over claims 1-88 of copending Application No. 10/585,818, over claims 1, 3, 4, 8, 18, 26, 27, 29, 35, 73, 75, 78, 81-89, and 87-89 of copending Application No. 10/670,478, over claims 1, 6, 8-57, 59, 60, and 62-104 of copending Application No. 11/086,906, over claims 1-106 of copending Application No.

11/089,210, over claims 1-121 of copending Application No. 11/858,994 in view of US 2006/0093568, over claims 1-121 of copending Application No. 11/859,004 in view of US 2006/0093568, over claims 92-121 of copending Application No. 11/859,015 in view of US 2006/0093568, over claims 65-69, 71, 72, 74, 76, and 78-147 of copending Application No. 10/528,698, over claims 77-80, 83-94, 97-107, and 109-161 of copending Application No. 10/529,266 in view of US 2006/0093568, over claims 80-83, 86, 87, 90-140, and 142-176 of copending Application No. 10/529,218, over claims 67-129 of copending Application No. 10/529,264, and over claims 95-101 and 105-216<sup>1</sup> of copending Application No. 10/529,318 for reasons as set forth at pages 6-13.

Solely to advance prosecution of this application, Applicants file herewith Terminal Disclaimers over aforementioned copending applications, each signed by an attorney of record in compliance with 37 C.F.R. § 1.321(c). Applicants respectfully submit that this Terminal Disclaimer obviates the rejection and request that it be withdrawn.

Applicants will submit a Terminal Disclaimer over copending Application No. 10/573,579 when its assignment information is available.

The Office further requires Applicants to either cancel the conflicting claims between the instant application and copending Application Nos. 10/528,698, 10/529,265, 10/529,267, and 11/086,906, from all but one application, or maintain a line of demarcation between the applications, for reasons as set forth at pages 13-15.

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1. The Office Action is not clear about this set of claim numbers. The claim numbers 10- 216 cited by the Office appear to be incorrect. Applicants assume that the claim numbers intended by the Office is 105-216.

Applicants submit that there is a line of demarcation between the claims. The claims in question are different in scope. For example, the currently pending claims are directed to a **cosmetic** composition comprising, in a cosmetically acceptable organic liquid medium, at least one **non-elastomeric** film-forming ethylenic linear block polymer and **at least one gelling agent** for the organic liquid medium, whereas the pending claims of copending Application No. 10/528,698 are directed to a **lip makeup** composition comprising at least one cosmetically acceptable organic liquid medium and at least one **styrene-free** film-forming linear block ethylenic polymer, **wherein the lip makeup composition has a resistive index of greater than or equal to 80%**. A mere difference in scope between claims has been held to be enough for their copending. See MPEP 706.03(k). As such, Applicants respectfully request that this requirement be withdrawn.

**V. Information Disclosure Statement**

Applicants respectfully request that the Office consider and initial Foreign Patent Document Nos. 155-160 cited on the SB/08 form submitted September 14, 2009. Regarding Foreign Document No 216 cited on the same SB/08, Applicants hereby clarify that it is the WO document instead of the EP document. Applicants apologize for any inconvenience that this might cause to the Office. Applicants respectfully request that the Office consider and initial Foreign Patent Document No. 216.

**CONCLUSION**


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 19, 2010

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